

REMARKS

Claims 1-3, 5, 7, and 10-12 are pending in the present application. Claims 15-24 have been added by this amendment, leaving Claims 1-3, 5, 7, 10-12 and 15-24 for consideration upon entry of this amendment. No new matter has been introduced by these amendments. In the Preliminary Amendment submitted on June 20, 2002, the Applicant's Representative mistakenly failed to include a copy of the marked up claims. The Applicant's Representative apologizes for the oversight and will be happy to provide one if requested. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

1. Claim Rejections Under 35 U.S.C. §103

Claims 1-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent Nos. 5,403,878 and 5,418,269 to Ishiwa et al. The Examiner has asserted that "it would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ particular amounts and/or parameters as known in the art, since it is well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality." (Paper 6, page 2) Applicant disagrees.

U. S. Patent No. 5,403,878 to Ishiwa et al. discloses a composition comprising polycarbonate resin and alpha-olefin oligomers. U. S. Patent No. 5,418,269 to Ishiwa et al. discloses a composition comprising polycarbonate resin and an ester of an aliphatic carboxylic acid and an alcohol. Both references disclose the optional inclusion of a sulfur-containing acidic compound having a pKa value of 3 or less. (269: Col. 10, line 30-Col. 11,

line 2, '878: Col. 8, line 58-Col. 9, line 25) Alkyl tosylates are part of a long list of compounds that meets this criteria. Both references also indicate that phosphorus containing compounds may optionally be included in the compositions as "process stabilizers (antioxidants)" ('269: Col. 11, line 29-Col. 12, line 10, '878: Col. 9, line 49-Col. 10, line 43). Phosphorous containing acids are included in the extensive list of phosphorous containing compounds. Neither reference teaches the explicit combination of an alkyl tosylates and phosphorous acid nor does either reference suggest that this particular combination is advantageous in any way.

The instant application teaches the unique advantages associated with the combination of alkyl tosylate, phosphorous acid and polycarbonate. The combination of alkyl tosylate and phosphorous acid is especially effective in quenching residual polymerization catalyst in polycarbonate. UV retention provides evidence of the catalyst quenching as discussed on page 6, lines 6-12. As discussed on page 6, lines 12-15, phosphorous acid alone is "ineffective to improve UV retention" but the combination of alkyl tosylate and phosphorous acid was more effective than even high levels of alkyl tosylate alone. In view of the finding that phosphorous acid alone is ineffective it is unexpected that the combination of phosphorous acid and alkyl tosylate at a first amount would achieve better UV retention (catalyst quenching) than alkyl tosylate alone at a second, higher amount.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled

artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that a prima facie case of obviousness has not been made because neither of the cited references provide motivation to combine alkyl tosylate and phosphorous acid with polycarbonate or an expectation of success with regard to this combination. Accordingly, Applicants believe that the claimed invention is non-obvious and earnestly request allowance of the pending claims.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862 maintained by the Assignee.

Respectfully submitted,

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